



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,866	09/15/2005	Anahit Tataryan	3361-US-1	1881

63543 7590 09/11/2009  
AVERY DENNISON CORPORATION  
Patent Group  
Law Department - 3 South  
P.O. BOX 7090  
PASADENA, CA 91109-7090

EXAMINER
----------

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
----------	--------------

1794

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

09/11/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rachele.wittwer@averydennison.com  
brian.martin@averydennison.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,866	<b>Applicant(s)</b> TATARYAN ET AL.	
	<b>Examiner</b> VICTOR S. CHANG	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009 and 30 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/30/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Introduction***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' amendments and remarks filed on 6/8/2009 and 3/30/2009 have been entered. Claims 53-62 have been cancelled. Applicant's election without traverse of Invention I (claims 32-52) is acknowledged. Claims 32-52 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response, the grounds of rejections have been updated as set forth below.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 48 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

More particularly, in claim 48, the term "the mailing article" lacks antecedent basis. Clarification is required in the next reply.

***Claim Rejections - 35 USC § 103***

6. Claims 32-52 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stipek [US 3914483].

Stipek's invention relates to a multiple part label. Figs. 1 and 2 illustrate a roll of labels 13 comprising in order an indicia carrying sheet 17 (facestock), a pressure sensitive adhesive layer 19 (second means), and a backing sheet 15 coated with release agent (release liner, or third means). The backing sheet is cut along a closed line 21 which is located inwardly of the periphery 23 of the label. The closed cut line 21 defines a backing portion 25 located entirely within the boundaries of the label 13. The indicia carrying sheet 17 is cut completely through along one closed line 31 thereby forming an inner removable label 33. The inner removable label 33 may have imprinted indicia 41. The indicia may be the name of the manufacturer, distributor, packer, etc., or other information for identifying a container or package [col. 1, ll. 45 through col. 2, ll. 29]. Figs. 5 and 6 illustrate that the relative die cut positions in the label carrying sheet 17 and the backing sheet 15 [col. 1, ll. 39-42].

For claims 32-46 and 48-52, in Stipek's Fig. 6, die cuts 51 and 53 read on the second and first the weakened lines, respectively. Stipek teaches all the features of the labels of the claimed invention. Regarding the term "first means" of "a print-receptive coating", since Stipek teaches that information for identifying indicia is imprinted on the label carrying sheet 17, the outer surface of the label carrying sheet reads on the "first means". Regarding the use languages throughout the claims, i.e., printing the indicia as "send-reply mailing address", and the steps of using the label for mailing, since statements of intended use do not serve to distinguish structure over the prior art, they have not been given any patentable weight. *In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). Alternatively, even if the use languages are

Art Unit: 1794

considered, the examiner takes Official notice that using a label with preprinted address for mailing is common and well known, therefore it would have been an obvious to one of ordinary skill in the art of label to modify Stipek's label with an indicia of preprinted address for mailing. Finally, regarding the use steps during mailing, since the process limitations have not been shown on the record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious, and this limitation at the present time has not been given patentable weight.

For claim 47, since Stipek teaches multiple labels 17 on a roll of backing sheet 15, the terms "third and fourth weakened lines" are read upon by similar die cuts in a second label.

### ***Response to Arguments***

7. In view of the new grounds of rejections set forth above, applicants' arguments are moot.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794